

REMARKS

The present Amendment is in response to the Examiner's Office Action mailed September 2, 2005. Claims 6 and 14 are cancelled, claims 1, 9, and 10 are amended, and new claim 21 is added. Claims 1-5, 7-13, and 15-21 are now pending in view of the above amendments.

Reconsideration of the application is respectfully requested in view of the above amendments to the claims and the following remarks. For the Examiner's convenience and reference, Applicant's remarks are presented in the order in which the corresponding issues were raised in the Office Action.

Please note that the following remarks are not intended to be an exhaustive enumeration of the distinctions between any cited references and the claimed invention. Rather, the distinctions identified and discussed below are presented solely by way of example to illustrate some of the differences between the claimed invention and the cited references. In addition, Applicants request that the Examiner carefully review any references discussed below to ensure that Applicants understanding and discussion of the references, if any, is consistent with the Examiner's understanding.

I. CLAIM REJECTIONS

A. Rejection Under 35 U.S.C. §102(a/b/e)

The Examiner rejects claims 1-5 under 35 U.S.C. § 102(b) as being anticipated by *Harwood* (United States Patent No. 4,186,999). Claim 1 has been amended to recite elements formerly presented in claim 6. Claim 1 as amended includes elements not rejected by the examiner. For example, claim 1 now includes the element, "wherein said recess is configured to receive a ferrule in friction-fit engagement" which was not alleged to be disclosed by *Harwood* by the Examiner. At least for this reason, the Applicant respectfully request that the rejection of claim 1 be withdrawn. Claims 2-5 depend from claim 1 and include each element of claim 1. Therefore, Applicants respectfully request that the rejection of claims 2-5 be withdrawn at least for the same reasons as claim 1.

B. Rejection Under 35 U.S.C. § 103

The Examiner rejects claims 1-20 under 35 U.S.C. § 103 as being unpatentable over applicant's Figures 1A and 1B in view of *Kang et al.* (U.S. Patent No. 6,629,780). Applicants traverse the rejection under 35 U.S.C. § 103 because the Examiner has failed to present evidence in a manner required to establish a *prima facie* case of obviousness under 37 CFR 1.104. Rule 1.104 requires the following:

In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

(Emphasis Added).

Moreover, MPEP 706 explains that “[t]he goal of examination is to clearly articulate any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity.” (Emphasis added). The rejection of claims 1-20 has not satisfied several requirements of rule 1.104 and therefore a proper *prima facie* case of obviousness has not been established.

MPEP section 2141 Section I sets forth the standard for patentability to be applied in obviousness rejections. “Patent examiners carry the responsibility of making sure that standard of patentability enunciated by the Supreme Court and by the Congress is applied in each and every case.” MPEP 2141 (emphasis in original). “Office policy is to follow *Graham v. John Deere Co.* in the consideration and determination of obviousness under 35 U.S.C. 103.... [T]he four factual inquiries enunciated therein as a background for determining obviousness are as follows: (A) Determining the scope and contents of the prior art; (B) Ascertaining the differences between the prior art and the claims in issue; (C) Resolving the level of ordinary skill in the pertinent art; and (D) Evaluating evidence of secondary considerations.... Accordingly, examiners should apply the test for patentability under 35 U.S.C. 103 set forth in *Graham*.” MPEP 2141 (emphasis added).

The Office Action fails to properly apply the test set forth in *Graham*. The Examiner's entire analysis includes seven lines of vague references to *Kang* and unsupported assertions of motivation for the proposed combination, without a single reference to a page, line, or figure of *Kang*. *Kang* includes 44 figures and 30 columns of text and in instances such as here the Examiner is required to clearly articulate where in the evidence supplied rationale for the rejection can be found. The Applicant respectfully requests that the Examiner clearly and particularly articulates all rejections for each claim with reference to column, line number, and figures relied upon for any rejections.

The Applicant further traverses the rejection of claims 1-20 under 35 U.S.C. § 103 as being unpatentable over Applicant's Figures 1A and 1B in view of *Kang* because the proposed combination fails to teach each and every element of the present invention. Regarding claim 1, the Examiner has not established that the proposed combination discloses a "recess having a first internal perimeter, and a second internal perimeter, wherein said first perimeter is smaller than said second perimeter, wherein said recess is configured to receive a ferrule in friction-fit engagement." Rather, the Examiner merely states that it would be obvious to use a wider opening in the Applicant's Figures 1A and 1B "to make the insertion of the ferrule into the base easier." Similar deficiencies exist in the rejection of claim 10. Moreover, the Examiner fails to address any of the specific elements of any of claims 1-20 and to point out where each element can be found in the cited references.

Applicants further traverse the motivation set forth in the Office action for the proposed combination. It is error to reconstruct the Applicant's claimed invention from the prior art by using the patentee's claim as a "blueprint." When prior art references require selective combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight obtained from the Applicant's invention itself. It is critical to understand the particular results achieved by the new combination. *Interconnect Planning Corp v. Feil*, 774 F.2d 1132, 227 USPQ 543 (Fed. Cir. 1985).

Kang discloses pieces within a connector for receiving optical fibers having "a wide opening on the side where fibers will be inserted while having a narrower opening at the point

where the fibers exit....” Col. 18, lines 26-29; *also see* Figures 12-15. These portions are for receiving fibers within a female format ferrule. *See* Title and Abstract. These portions of various widths do not, however, relate to a base connector for receiving another connector in a friction-fit engagement. Rather these portions are used to guide a fiber within a connector (col. 18, lines 26-29) as opposed to being configured to reduce deformation of a ferrule received by the connector.

The fibers in *Kang* are “inserted through the low-precision piece and then through the high-precision piece so as to terminate in, or just beyond, the outer face of the high precision piece. The low-precision piece is then filled with epoxy to hold the fibers in place via, for example, an inlet formed in the piece.” Col. 16, lines 35-39. Because *Kang* relates to a connector where the fibers are held in place by an epoxy, rather than a friction fit, there is no deformation of the fibers and one would not be motivated to combine the teachings of *Kang* with Figures 1A and 1B of the Applicant’s disclosure.

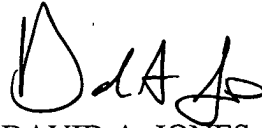
In *Kang*, the accuracy of the alignment is of a high importance (on the order of one micron). *See* Col. 16, lines 59-63. The Examiner has not established that such alignment issues relied on in the Office Action are present in Figures 1A and 1B of the Applicant’s disclosure to motivate one to include various precision portions in the embodiments of Figures 1A and 1B as alleged in the Office Action. Rather, Figures 1A and 1B illustrate the problem addressed by the Applicant’s invention, the problem of deformation of a ferrule caused by a friction fit engagement in a connector. No such friction-fit engagement is illustrated in *Kang*. Therefore, Applicant respectfully requests that the rejection of claims 1-20 be withdrawn as relying on impermissible hindsight reconstruction of the Applicant’s claimed invention.

CONCLUSION

In view of the foregoing, Applicants believe the claims as amended are in allowable form. In the event that the Examiner finds remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview, or which may be overcome by an Examiner's Amendment, the Examiner is requested to contact the undersigned attorney.

Dated this 2 day of February, 2006.

Respectfully submitted,



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